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In re Application of
WITTWER, Bruno
Application No.: 09/831,615
PCT No.: PCT/AU99/00992
Int. Filing Date: 10 November 1999
Priority Date Claimed: 10 November 1998
Attorney Docket No.: 19724-87004
For: PISTON PUMP

DECISION ON
PETITION
UNDER 37 CFR 1.47(b)

This decision is in response to applicant's "Petition Under 37 CFR §1.47(b)," ("Pet.") filed 27 August 2001.

BACKGROUND

On 10 May 2001, applicant filed a transmittal letter for entry into the national stage in the United States under 35 U.S.C. 371 which was accompanied by, *inter alia*, an unexecuted declaration.

On 25 June 2001, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) and Notification of a Defective Oath or Declaration (Form PCT/DO/EO/917) indicating that a signed oath/declaration in compliance with 37 CFR 1.497(a) and (b) must be provided.

On 27 August 2001, applicant submitted the instant petition which was accompanied by, *inter alia*, the \$130.00 petition fee; a copy of document titled "Agreement" ("Assignment") between Solar Energy Systems Pty Ltd. ("Solar") and the sole inventor, Mr. Bruno Wittwer ("Wittwer"); a letter from Solar to Wittwer dated 22 June 2001; and an email sent by Wittwer to Greg Allen dated 14 August 2001.

DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by (1) the requisite petition fee, (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is

necessary to preserve the rights of the parties or to prevent irreparable damage.

The appropriate petition fee of \$130.00 has been paid. The last known address of Wittwer addressed is listed as:

21 Southbourne Street
Scarborough Western Australia 60119
Australia

Therefore, items (1), and (3) have been completed.

Concerning item (2), section 409.03(d) of the Manual of Patent Examining Procedure (MPEP) states, in part:

A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers . . .

It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. *In re Gray*, 115 USPQ 80 (Comm'r Pat. 1956).

A review of the papers filed shows no evidence that Wittwar was presented with a complete copy of the application, including claims and drawings as well as an assignment and declaration. Consequently, the email dated 14 August is not considered an express refusal since the 37 CFR 1.47(b) applicant has failed to demonstrate that the sole inventor was presented with a complete copy of the application so as to be aware of all potential consequences of his refusal. Moreover, section 409.03(d) also states:

If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

Wittwar refers to an email sent by him on "9.7.01" in the email dated 14 August 2001. A copy of this email should be submitted with any renewed petition as well as any other documentary evidence such as letters, emails, etc. held by the 37 CFR 1.47(b) applicant that pertains to the purported refusal of Wittwar to sign the above-captioned application. For these reasons, item (2) is not satisfied.

Concerning item (4), applicant has not submitted a declaration signed by a representative of the 37 CFR 1.47(b) applicant on behalf of Wittwar. Therefore, item (4) is not complete. Section 409.03(b)(A) of the MPEP states, in part:

The 37 CFR 1.47(b) applicant must make the oath required by 37 CFR 1.63 and 1.64 or 1.175. Where a corporation is the 37 CFR 1.47(b) applicant, an officer (President, Vice-President, Secretary, Treasurer, or Chief Executive Officer) thereof should normally sign the necessary oath or declaration. A corporation may authorize any person, including an attorney or agent registered to practice before the U.S. Patent and Trademark Office, to sign the application oath or declaration on its behalf. Where an oath or declaration is signed by a registered attorney or agent on behalf of a corporation, either proof of the attorney's or agent's authority in the form of a statement signed by an appropriate corporate officer must be submitted, or the attorney or agent may simply state that he or she is authorized to sign on behalf of the corporation. Where the oath or declaration is being signed on behalf of an assignee, see MPEP § 324.

With regards to item (5), applicant submitted a copy of the Assignment between Solar and Wittwer signed by Wittwer. Pet. ¶ 3. Applicant claims proprietary interest in the above-captioned application pursuant to paragraph 1.1 and 6.3 of the Assignment. Id. at ¶ 4. Section 409.03(f) of the MPEP, states, in part:

If the application has been assigned, a copy of the assignment (in the English language) must be submitted. The assignment must clearly indicate that the invention described in the 37 CFR 1.47(b) application was assigned to the 37 CFR 1.47(b) applicant. **A statement under 37 CFR 3.73(b) by the assignee must also be submitted (see MPEP § 324) . . .** When an inventor has agreed in writing to assign an invention described in an application deposited pursuant to 37 CFR 1.47(b), a copy of that agreement should be submitted. **If an agreement to assign is dependent on certain specified conditions being met, it must be established by a statement of facts by someone with first hand knowledge of the circumstances in which those conditions have been met.** (Emphasis added).

A review of the Assignment corroborates applicant's claim that certain intellectual property subject to the conditions specified in paragraph 6.3 of the Assignment was sold to Solar by BW Solar Business. However, it is not clear if the above-captioned application meets the conditions specified by paragraph 6.3.

A statement by a person having firsthand knowledge of the facts, specifically,

that all conditions of paragraph 6.3 were met pertaining to the above-captioned application is required. Moreover, the required statement under 37 CFR 3.73(b) was also not submitted. See above. For these reasons, item (5) is not satisfied.

Concerning item (6), section 409.03(g) of the MPEP states that "[i]rreparable damage may be established by a showing (a statement) that a filing date is necessary to preserve the rights of the party or to prevent irreparable damage. However, applicant has not made the requisite statement in any of the papers submitted. Accordingly, applicant has not satisfied item (6).

Since applicants failed to meet item(s) (2), (4), (5) and (6), it is not appropriate to accept this application under 37 CFR 1.47(b) at this time.

CONCLUSION

For the reasons discussed above, applicant's petition under 37 CFR 1.47(b) is DISMISSED without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.



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